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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 677

THE GUIBERSON CORPORATION AND DRESSER INDUSTRIES, INC., *Petitioners,*

v.

JACK C. WEBBER AND MISSION MANUFACTURING COMPANY, *Respondents*

BRIEF FOR RESPONDENTS OPPOSING PETITION FOR WRIT OF CERTIORARI

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SUBJECT INDEX

	Page
As to the Alleged Questions Presented	2
As to the Statutes Involved	3
Summary of Lower Courts' Opinions	3
As to Petitioners' Argument	4
Answering Point 1	4
Answering Point 2	6
Answering Point 3	7
Conclusion	9
Certificate of Service	9

LIST OF AUTHORITIES

CASES	Page
Clark v. Murray, 219 F.2d 313	5
Cornell v. Adams Eng. Co., 258 F.2d 874	5
Glitsch v. Wyatt, 224 F.2d 331, CA 5 (1955)	5
Graham v. Jeoffroy, 206 F.2d 769	5
Jeoffroy v. Graham, 219 F.2d 511	5
Keller v. Adams-Campbell Co., 264 U.S. 314, 319 (1924)	2
Layne & Bowler Corp. v. Western Well Works, Inc., et al., 261 U.S. 387, 393 (1923)	2
Louis Dreyfus & Cie v. Panama Canal Company, 298 F.2d 733 (5 Cir. 1962)	8
Ritchie v. Lewis, 196 F.2d 434	5
Robinson v. DiGaetano, 212 F.2d 1	5
The Great Atlantic and Pacific Tea Company v. Supermarket Equipment Corporation, 71 S.Ct. 127 (1950)	3
United States v. El Paso Natural Gas, 376 U.S. 651	7
UNITED STATES STATUTES	
35 U.S.C. 102	3
35 U.S.C. 103	3
35 U.S.C. 112	3,7

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To The Honorable The Chief Justice and Associate Justices of The Supreme Court of the United States:

This is an ordinary patent case involving Webber Patent No. 2,633,808, entitled "Well Swab" (R. Ex. Vol. p. 1).

There are no conflicting decisions of different circuits on this Webber patent. There is no important or unsettled question of Federal Law raised in the Petition which requires decision by this Court.

Petitioners have not presented any ground which justifies the granting of the Petition.

AS TO THE ALLEGED QUESTIONS PRESENTED

Petitioners set forth five questions upon which review is sought. These questions are the *same* as those which were urged before both the Trial Court and the Court of Appeals. Therefore, they constitute a request that this Court review an ordinary patent case in which the usual issues of invention and infringement have been decided. As this Court stated in *Keller v. Adams-Campbell Co.*, 264 U.S. 314, 319 (1924):

> "Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

In *Layne & Bowler Corp. v. Western Well Works, Inc., et al.*, 261 U.S. 387, 393 (1923), the Supreme Court held that the writ of certiorari should not be granted:

> "* * * except in cases involving principles, the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal. * * *"

Petitioners assert that the evidence was "undisputed", but such assertion finds no support in the record. On the contrary, the critical issues were decided upon disputed evidence as to the structure, operation and function of many prior art devices which were relied upon by Petitioners at the trial (R. Ex. Vol. Ex. 7-18, 21-27, 59 and 72-77). The lower courts resolved the disputed facts in favor of Respondents.

AS TO THE STATUTES INVOLVED

There is no reason for the Supreme Court to consider in this case Sections 102, 103 and 112 of Title 35 because the courts below have not decided any question with respect thereto.

Furthermore, Petitioners have confused the "standard of invention" rule, as pronounced by this Court in the *A & P* case,* with the "conditions for patentability" requirements of Sections 102 and 103. These sections, by their very words, assume an invention has been made and relate solely to whether or not the invention is patentable. As distinguished from this, the "standard" laid down relates only to whether or not a device constitutes an invention.

There is nothing in the present record to support Petitioners' assertions that the courts below did not apply the proper "standard" of invention or that the invention did not meet the conditions for "patentability" as required by Sections 102 and 103. As is hereinafter shown, Section 112 supports the decision reached in the case.

SUMMARY OF LOWER COURTS' OPINIONS

Respondents brought suit charging Petitioners with infringement of Webber Patent No. 2,633,808. The patent relates to a particular well swab. The Court of Appeals unanimously affirmed the Trial Court, holding the patent valid and infringed. There is no conflict of decision involving the patent.

Upon the evidence presented, the Trial Court entered detailed findings, which found that the problems solved

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*The Great Atlantic and Pacific Tea Company v. Supermarket Equipment Corporation, 71 S.Ct. 127 (1950)

by the Webber swab had existed for thirty years and that others, including Petitioners, had attempted but failed to solve the problems (F.F. 7; R. 1291-2); that the Webber swab operates on an entirely new principle as compared to prior swabs (F.F. 8; R. 1292-3) and that the Webber swab solved the long-existent problems and was "a major step forward in the swabbing art" (F.F. 9; R. 1293).

The Court of Appeals* recognized the case as a "hard fought patent case" in which "long and exhaustive briefs" were submitted. Its opinion points out that "The district judge has written full, and, in our opinion, correct conclusions of fact and law." The opinion establishes that the record was fully reviewed since the history of the case is set forth followed by the Court's holding that:

> "We are of the clear opinion that the findings and conclusions and the judgment of the district judge as to both patents are correct and should be affirmed."

The Court of Appeals' opinion refutes Petitioners' statement that it is a "per curiam-like" opinion. Where the trial court has entered detailed findings of fact fully supporting its conclusions and judgment, there is no need for the appellate court to repeat, as the Court of Appeals stated, by "undertaking to set the findings and conclusions out". The Court of Appeals reviewed the record and affirmed. It followed proper appellate practice.

AS TO PETITIONERS' ARGUMENT

Answering Point 1

Petitioners erroneously assert that the lower courts failed to apply the "high standard of invention" required by the

*Opinion reported at 336 F.2d 461 (1954)

Supreme Court in the *A&P* case, supra. However, there is no support in the Petition or in the record for this assertion, and it is a mere *assumption* on Petitioners' part.

The Petition *admits* that the Fifth Circuit Court of Appeals has applied the standard of invention pronounced by the Supreme Court in the *A & P* case, citing *Glitsch v. Wyatt*, 224 F.2d 331, CA 5 (1955). Actually, the Fifth Circuit Court of Appeals has consistently applied such standard and has established the same as the law of this circuit. *Ritchie v. Lewis*, 196 F.2d 434; *Graham v. Jeoffroy*, 206 F.2d 769; *Cornell v. Adams Eng. Co.*, 258 F.2d 874; *Robinson v. DiGaetano*, 212 F.2d 1; *Clark v. Murray*, 219 F.2d 313; *Jeoffroy v. Graham*, 219 F.2d 511.

There is nothing in the opinion of the Fifth Circuit Court of Appeals to support the bare assertion that it departed from its own precedent in applying the proper standard of invention.

The authorities cited by Petitioners at pages 13-15, which refer to decisions in other circuits, are not pertinent to the question of whether or not the Fifth Circuit Court departed from its own precedent.

The Trial Court's detailed findings and conclusions—affirmed by the Appeals Court—clearly demonstrate that the proper standard of invention was applied.

Petitioners erroneously state that, "It is without dispute that the novelty claimed for the patent in suit is a sealing element" having a rubber flange or flanges which fold down in response to pressure. And, say Petitioners, the "trial court so found", citing Finding 8 (Appendix p. A-6, Petition). A consideration of Finding 8 shows this statement to be without substance because said Finding defines

the Webber swab as something more than a rubber flange which folds down; it brings out the *relationship* of each sealing ring of the swab to the particular well pipe in which it is used, refers to the trailing or inverted position of each sealing ring while carrying its liquid load and sets forth the automatic by-pass under overload. It is the overall combination which causes the Webber swab to operate "on an entirely new principle", and Petitioners carefully ignore any reference to such combination.

Petitioners assert that the invention falls into the category of the "ridiculous" inventions listed by Justice Douglas in his concurring opinion in the *A&P* case, supra, but this assertion finds no support in the record. On the contrary, the invention is a valuable and necessary well tool which was perfected and brought to market only after many years of experimental work (R. 46, 145-148, 150, 159, 397; Ex. Vol., PX 54, 55, 56, pp. 76, 90, 109). It was a commercial success (R. 293, 325, 327, 338) because it effectively solved the major problems which had been existent for "at least thirty years" (F.F. 7; R. 1291). It constituted, as the lower courts agreed, a "major step forward in the swabbing art" (F.F. 9; R. 1293).

Answering Point 2

Petitioners' arguments that the claims are functional were repeatedly urged before the Trial Court and again before the Court of Appeals. These argument were rejected when the Trial Court found that "The Webber swab, as disclosed and *claimed* in the patents-in-suit, constituted a major step forward in the swabbing art". (F.F. 9; R. 1293) (emphasis added). The Court of Appeals agreed.

The authorities cited by Petitioners in support of their argument that the claims are functional are not pertinent since they are all prior to 1952, the effective date of 35 U.S.C. § 112. This section specifically provides that an element may be expressed as a means for performing a specified function, and the pertinent portion is as follows:

> "An element in a claim for a combination *may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof,* and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." (emphasis added)

Therefore, even if it be assumed that some functional statements are included in the claims, the claims meet statutory requirements. The lower courts' opinions are in conformity with section 112 and Petitioners' assertions are without merit.

Answering Point 3

Petitioners take the untenable position that because the Trial Court adopted findings submitted by counsel, such findings should be reviewed by the Supreme Court. Petitioners rely upon *United States v. El Paso Natural Gas,* 376 U.S. 651. Such case is distinguishable because the record was "composed largely of undisputed evidence", whereas in the present litigation, the evidence presented by each party as to the prior art devices—and particularly as to the type, structure, function and operation of prior art swabs—was in direct conflict. The conflict was resolved in favor of Respondents.

Furthermore, the record reflects that the District Court did not merely "mechanically adopt" findings, but instead carefully studied all proposed findings of *both* parties. The District Court then adopted some of Respondents' proposed findings, some of Petitioners' proposed findings, at least one of Petitioners' findings with modifications, and then added findings in the form of comments composed and written by the court itself.

It is interesting to note that Respondents proposed a total of 23 findings and 11 conclusions of law (R. pp. 1226-1246); Petitioners proposed a total of 55 findings and 10 conclusions of law (R. pp. 1243-1260). The comparison of these findings to the District Court's final 20 findings (including some of its own) and 7 conclusions (also at least one of its own) establishes beyond question that there was no "mechanical adoption" of stereotyped findings by the District Court in this case.

Additionally, the courts have recognized that in complex and technical patent cases, the assistance given the trial court by the submission of proposed findings is almost indispensable. As was said in *Louis Dreyfus & Cie v. Panama Canal Company*, 298 F.2d 733 (5 Cir. 1962):

> "* * * This assistance may be especially helpful in a case involving complex and technical subject matter, as in patent cases, where the aid of a specialist may be but a shade short of indispensable. In such cases it might be assumed that the trial judge considered the case from all angles and reached his decision independently *before* placing reliance on the proposed findings. * * *"

Here, the proposed findings served to assist the trial judge who, after full consideration, selected some from

the Respondents, some from the Petitioners and prepared some of his own. There is no support in the record for the position taken by Petitioners.

CONCLUSION

The Petition asserts no conflict of decisions as to the Webber patent, and no important question of Federal Law which requires decision by this Court is raised. The Petition is, in effect, a request for this Court to review an ordinary patent case between private parties. The Petition is without merit, in fact and in law, and should be denied.

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CERTIFICATE OF SERVICE

A copy of the foregoing Brief for Respondents Opposing Petition for Writ of Certiorari has been served on Petitioners' counsel by first class air mail, postage prepaid, addressed to Frank J. Scurlock and Howard E. Moore at their respective addresses of record on this _____ day of December, 1964.

Counsel for Respondents